

REMARKS

I. Introduction

Claims 13-24 are pending in the Application. In view of the following remarks and arguments, Applicant respectfully submits that the Application is in condition for allowance and respectfully solicits a notice stating the same. Prompt reconsideration is respectfully requested.

IV. Claim Rejections Under 35 U.S.C. § 103

On pages 2-5 of the Office Action dated April 18, 2006, claims 13-24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,215,870 to Hirai et al. (Hirai) in view of U.S. Patent No. 6,208,734 to Ortscheid et al. (Ortscheid). The rejection is respectfully traversed for failing to establish a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See M.P.E.P. § 2143. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. M.P.E.P. § 2143.01(III) (citing *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990)). Here, the Office Action fails to provide the requisite suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify Hirai or to combine the teachings of Hirai and Ortscheid. In fact, modifying Hirai according to the teachings of Ortscheid would destroy Hirai's principle of operation. Furthermore, the prior art reference (or references when combined) fail to teach or suggest all the claim limitations.

Claim 13 in the instant application recites, *inter alia*, “a mating contact unit for engaging the contact mechanism of the telephone, ***said mating contact unit being pivotable through a pivot angle and longitudinally displaceable in the holder***” (emphasis added). Paragraph 5 of the disclosure states that the claimed apparatus allows insertion of telephones of a wide range of different dimensions, does not yield as the telephone is placed in position and removed, and, for the purposes of placing in position and removal, moves the telephone into an ergonomically optimal position for the user. Furthermore, paragraph 0009 provides that the ergonomically optimal attachment/discharge position is achieved by pivoting the mating contact unit 45° to 135° in relation to the main plane of the holder.

In contrast, Hirai discloses a phone holder, a first embodiment of the phone holder including an outer box 10, a connector module 20, a phone ejector module 30, an inner bottom frame 40, an adjustment module 70, and a ceiling wall 80 (FIGS. 1-2; column 4, lines 59-62). Further details of Hirai were set forth in the previous response filed January 4, 2006. In operation, phone T is longitudinally inserted into the phone holder main body 10,80 and connects to holder connector C of connector module 20 while holder connector C is being retracted (FIGS. 12-13; column 12, line 58 – column 13, line 13; *see also* FIGS. 7, 8; column 2, lines 15-40). The Office Action states that “Hirai does not teach the mating contact unit being pivotable through a pivot angle” and cites Ortscheid as teaching a mating contact unit being pivotable through a pivot angle. *See* Office Action, pages 2-3. The Office Action states that “it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate Ortscheid’s pivot feature into Hirai’s apparatus in order to have the mating contact unit being pivotable through a pivot angle” because a “pivot feature is very popular in communication holding device [sic].” Office Action, page 3. The Applicant respectfully disagrees and submits that the purported suggestion or motivation for modifying Hirai or for combining the references is improper for at least the following three reasons.

First, there is nothing in Hirai that suggests the desirability or need for the connector module 20 or holder connector C to pivot. Similarly, there is nothing in Ortscheid that suggests the desirability or need to incorporate a pivot feature in combination with a longitudinally sliding contact module such as that of Hirai. The Applicant respectfully submits that the statement that the “pivot feature is very popular in communication holding device [sic]” (Office Action, page 3) is not sufficient to establish a *prima facie* case of obviousness. Therefore, the Office Action fails to provide the requisite suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify Hirai or to combine the teachings of Hirai and Ortscheid.

Second, including such a pivot feature would destroy Hirai’s principle of operation. *See* M.P.E.P. § 2143.01(VI) (if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.). According to Hirai, the phone holder according to the invention includes “position fixing means for adjusting a relative position of the holder connector to the holder main body ***in a direction normal to a connecting direction of the mobile phone*** and fixing the holder connector to the holder main body.” Hirai, column 2, lines 21-25 (emphasis added). “Accordingly, the connecting and disconnecting operation of the phone connector to and from the holder connector can be facilitated by merely inserting and ejecting the mobile phone in and out of the holder main body irrespective of the various positions of the phone connector. *See, e.g.,* FIGS. 9, 10, and 12. Thus, the structure of Hirai purportedly fixes the position of the holder connector C relative to the holder main body 10,80 in a direction normal to a connecting direction of the mobile phone T to facilitate connection and disconnection of phone T irrespective of the various positions of the phone connector on phone T. Therefore, the addition of a pivot feature would destroy this principle of operation since any rotation of Hirai’s holder connector C within holder main body 10,80 would inhibit connection and disconnection of phone T with holder connector C upon insertion and ejection of phone T in and out of holder main body 10,80 in a connecting direction.

Third, even assuming, *arguendo*, that the combination of Hirai and Ortscheid was proper, the combination fails to teach each and every element recited in the claims. The Office Action states that “Hirai does not teach the mating contact unit being pivotable through a pivot angle” and cites Ortscheid for such a teaching. Ortscheid teaches a plug-in connector 19 inserted into a carrier 7. Citation to item 111 on page 3 of the Office Action is misplaced since this is merely described in Ortscheid as “recesses” on telephone for accommodating stop blocks 110 on the carrier 7. *See* FIG. 10, column 7, lines 54-57. Importantly, however, the carrier 7 is pivotable with respect to a base element 2. *See* Ortscheid, FIGS. 1-3, 6, and 7. Thus, the plug-in connector 19 is not pivotable through a pivot angle with respect to the carrier 7. As noted above, claim 13 requires “said ***mating contact unit*** being pivotable through a pivot angle and longitudinally displaceable in the holder.” Therefore, even if Hirai and Ortscheid were properly combined, the teachings of Ortscheid would, at most, suggest making holder main body 10,80 pivotable with respect to a base element, rather than making the holder connector C pivotable relative to the holder main body 10,80.

In view of the foregoing, it is respectfully submitted that neither one of Hirai nor Ortscheid, either alone or in combination, teaches or suggests a mating contact unit for engaging the contact mechanism of the telephone, said ***mating contact unit being pivotable through a pivot angle and longitudinally displaceable in the holder***, as required by at least claim 13. The Office Action fails to establish a *prima facie* case in at least this regard. Claims 14-24 depend variously from claim 13 and are, therefore, submitted as being allowable for at least the same reasons. Reconsideration and withdrawal of the rejection are respectfully requested.

V. Conclusion

For the foregoing reasons, it is submitted that claims 13-24 are allowable and that the application is in condition for allowance. An early notice to that effect is respectfully requested.

It is not believed that extensions of time or other fees are required beyond those that may otherwise be provided for in documents accompanying this paper. If, however, additional extensions of time are needed to prevent abandonment of this application, such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor (including

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Appl. No. 09/914,385

fees for net addition of claims or any other fee deficiency), are hereby authorized to be charged, and any overpayments credited to, our Deposit Account No. 22-0261.

The Examiner is respectfully requested to contact Applicant's undersigned Representative if necessary to place the application in condition for allowance. Prompt reconsideration is respectfully requested.

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Respectfully submitted,



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